REMARKS

Claims 1, 3-29, and 40-49 are pending. Reconsideration and further examination is respectfully requested.

Response to Rejection Under 35 USC §103(a)

Claims 1, 3-29 and 40-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landry (U.S. Patent 5,649,117) in view of Wilkinson (US 2001/0034695A1). This rejection is respectfully traversed.

The grounds of rejection set forth by the Examiner in the third paragraph appear directed at the limitations of claims 1 and 25. There is no specific discussion of any of the features of the other rejected claims (e.g., claims 2-24, 26-29, and 40-49). Because of the many distinct features of these claims, the Examiner's omnibus rejection is improper. See M.P.E.P § 707.07 (d) ("A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.") For this reason the Examiner is respectfully requested to withdraw the rejection of these claims.

With respect to claims 1 and 25, references fail to establish a *prima facie* case of obviousness. MPEP § 2142 states "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

From the facts derived from the references, there is no suggestion or motivation to modify the references or to combine their teachings, as required by MPEP §2143.01. Landry discloses a system for paying bills or other voluntary or involuntary obligations of payors without requiring interaction with the payors (col. 1, lines 5-10). In Landry, a bill generator uses payor and payee information to generate bill records. A message generator generates EFT messages for transferring funds electronically between payors and payees. Wilkinson provides a centralized intellectual property market in which one or more financial instruments may be exchanged in one or more transactions for a tangible value (page 1, paragraph [0004]). Wilkinson accepts bids from parties interested in acquiring one or more of non-tangible assets, matches the bids to the asking positions, and facilitates the transaction. The Examiner asserts that it would have been obvious to one skilled in the art to combine the teachings of Landry and Wilkinson "because it would determine the market value per share of the intellectual property asset (non-cash donatable items) to be offered on the market and make the shares available for exchange of the market."

Applicant respectfully asserts that the combination suggested by the Examiner is improper. Neither Wilkinson nor Landry includes teachings that would lead one of ordinary skill in the art to combine the references at all, let alone in the suggested manner. There is simply no logical or practical relationship between systems used to pay bills, such as Landry, and systems for exchanging patents, copyrights, trademarks and other intellectual property, as taught by Wilkinson. Such systems operate on entirely

unrelated problems (bill payment vs. intellectual property management), use entirely different operational models (party to party funds transfers vs. multi-party markets), and would likely be used by entirely dissimilar users (individuals paying their own bills vs. corporate officers on behalf of a company). Nothing in Landry teaches the need for an IP marketplace, and there are no teachings that Wilkinson's IP marketplace should be combined with the bill payment system of Landry. Thus, a person of ordinary skill in the art would not find it obvious to turn to the centralized intellectual property market that accepts bids for IP assets to combine it with the bill payment mechanism of Landry in order to provide the claimed mechanism for tracking charitable donations.

Second, even if such a combination were suggested, the combination of the teachings of these references is still completely deficient, contrary to the requirements of MPEP §2143.03. At best, such a combination would provide a bill payment mechanism for IP assets, so that successful bidders could make payments to the intellectual property owner. This alone does not provide any way to provide for tracking of charitable donations, as asserted by the Examiner, which by definition is not being sold or auctioned as in Wilkinson's IP market.

Accordingly, since there was no suggestion in the references to make the suggested combination or modification, and because such a combination fails to teach, suggest or motivate what the Examiner asserts, the rejection of claims 1 and 25 is unsupported by the art and should be withdrawn.

With respect to claims 10, 40, and 41, the references fail to establish a *prima facie* case for an obviousness rejection. Contrary to the Examiner's suggestion, Landry does not disclose or suggest one or more partner servers adapted to electronically capture sales

data of items sold at a data source. Nor does Landry disclose or suggest a system server that periodically receives the captured sales data from the partner servers. Landry has nothing to do with capturing sales data.

Contrary to the Examiner's contention, the addition of Wilkinson does not cure the deficiency of Landry. Wilkinson fails to disclose or suggest one or more partner servers adapted to electronically capture sales data of sold items at a data source. Similarly, Wilkinson fails to disclose or suggest a system server that receives the captured sales data from partner servers. Although Wilkinson discloses that valuation data for IP assets is gathered, Wilkinson glosses over this subject and provides little explanation as to how the evaluation data is gathered (page 4, paragraph [0032]). Moreover, Wilkinson provides no means for electronically capturing sales data of sold items. Therefore, the rejection of claims 10, 40, and 41 is unsupported by the references and should be withdrawn.

Contrary to the Examiner's contention, Landry does not disclose or suggest determining whether a tax-deductible valuation is sufficient to require filing out IRS Non-cash Charitable Contributions form, as recited in claim 19, as Landry has nothing to do with tax preparation. Although Wilkinson discloses that a tangible value of an intellectual property asset may comprise a tax value, Wilkinson has nothing to do with taxes, determining tax deductions, or tax preparation. Thus, the suggested combination does not teach a system for tracking charitable donations, as asserted by the Examiner. In addition, contrary to MPEP §2141.01(a), one of skill in the art would not consider Wilkinson to be analogous art with sufficiently relevant teachings, nor would one be motivated to combine Wilkinson with Landry. Accordingly, the suggested combination

does not teach or suggest all of the claim limitations. Therefore, the rejection of claim 19 is unsupported by the references and should be withdrawn.

With respect to claims 42 and 49, contrary to the Examiner's contention, Landry does not disclose or suggest electronically transmitting the tax deductible valuation to the income tax preparation application. Wilkinson does not cure the deficiency of Landry. As previously discussed, Wilkinson in particular has nothing to do with taxes and determining tax deductions. Accordingly, the suggested combination does not teach or suggest all of the claim limitations. In addition, one of skill in the art would not consider Wilkinson to be analogous art with sufficiently relevant teachings, nor would one be motivated to combine Wilkinson with Landry. Therefore, the rejection of claims 42 and 49 is unsupported by the reference and should be withdrawn.

Claims 20-24, 26-29, and 43-48 are dependent claims that incorporate all of the limitations of at least one claim discussed above, and that further recite additional features and limitations.

Accordingly, for at least the reasons given above, Applicant respectfully submits that the rejections of claims 1, 3-29 and 40-49 based on the combination of Landry and Wilkinson are unsupported by those references and should be withdrawn.

Based on the above remarks, consideration of this application and the early allowance of all claims herein are requested. Should the Examiner wish to discuss the above remarks, or if the Examiner believes that for any reason direct contact with Applicants' representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,
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